



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,039	09/21/2000	William J. Beyda	00P7906US	9089

7590 09/14/2004

Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,039

Applicant(s)

BEYDA, WILLIAM J.

Examiner

Bunjoo Jaroenchonwanit

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 and 19-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 6-18 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In response to communication filed 7/14/2004, the amendment and argument have been reviewed, cited as stated below.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the access restriction filter configured to interrogate for an access code applicable to non-electronic distribution, in claim 1, 14 and 29, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode

contemplated by the inventor of carrying out his invention.

4. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to make/or use the invention, i.e., failing to disclose how to interrogate access code from non-electronic distribution of electronic message.

Applicant's disclosure is insufficient to allow one of ordinary skill in the art to make or use the invention without undue experimentation because applicant did not adequately disclose the necessary apparatus to perform the claimed method. See In re Gunn, 190 USPQ 402, 406 (CCPA 1976.) In fact applicant's disclosure did not even mention anything related to non-electronic messaging distribution on which the claimed method could be implemented.

5. Claims 1-5, 14-18 and 29-32 are rejected under 35 U.S.C. 112, first paragraph, for reason set forth in the objection to the specification.

It is suggested that applicant could overcome 112/first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-indexing in the detailed description to reference numerals on said system diagrams.) No new matter should be added.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3, 5, 14-16, 18 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumura (US. 5,842,023).

8. Regarding claims 1, 14 and 29, Tsumura discloses, a method, apparatus and program (hereinafter collectively referred to as a "system"), for an electronic messaging system, comprising an access restriction filter configured to interrogate an electronic message for an

Art Unit: 2143

access restriction notice in response to a user command to transmit the electronic message, and to respond to a detected access restriction notice in accordance with a prescribed transmission policy (see fig 2, 4, and 5; Col.12, lines 13-63; Col. 16, line 40-Col. 17, line 37, Col. 20, lines 1-39). Tsumura does explicitly disclose the restriction notice is applicable for non-electronic distribution of electronic message. Since the specification in nowhere defined what was and non-electronic distribution neither the claimed invention intended nor how to distribute electronic message in non-electronic manner. In bona fide attempt examination, the reasonable interpretation of the claims as written is that the electronic message is converted to paper, i.e., internal office memo, with a stamp such as confidential, restriction, copyright notice or etc, and distribute by messenger as routinely conducted within most of the corporation. It would have been obvious to one of ordinary skilled in the art at the time of the invention was made to implement a well-known and common message distribution as routinely practiced for distributing non-electronic form, e.g., manually distribution, of electronic message as claimed, with the motivation of ensuring reliability of messaging or as a back up messaging service.

9. Regarding claims 2, 3, 15 and 16, Tsumura discloses, the system of claim 2, wherein the access restriction filter is configured to detect a copyright notice in the electronic message (see fig 2, 4-5; Col.12, lines 13-63; Col. 16, line 40-Col. 17, line 37, Col. 20, lines 1-39).

10. Regarding claims 5, 18, Tsumura discloses, the system of claim 3, wherein the access restriction filter is configured to detect a copyright notice by interrogating a header component of the electronic message (see fig. 2 and 5, in blocks 21-24 represent a header of multimedia digital information in main body information in block 24; the copyright information is in block 23, see detail in fig. 5).

Art Unit: 2143

11. Regarding claims 30-32, in addition to the discussion in claims 1, 14 and 29 above, Tsumura, further, discloses, a system that capable of detecting ownership restriction component, e.g., copyright, from electronic messages, but fails to explicitly include detecting, other types of owner restriction, e.g., confidential. However, applying Tsumura's system, which readily capable of detecting copyright information, to detect confidential information, would have been obvious to one of ordinary skill in the art at the time of the invention was made that was a matter of implementation and design choice, which required minimum alteration and does not produce any unexpected result.

12. Claims 4 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsumura, as applied to claims 3 and 16, in view of Nakagawa et al, (US 2003/0159065).

13. Regarding claims 4 and 17, Tsumura discloses the invention substantially, as claimed, as described in their base claims, but silent to comparing characters in the electronic message to a copyright notice representation. However, in an analogous art, Nakagawa teaches a system for inspecting the copyright of electronic data in a network, which is capable of detecting, comparing characters with copyright notice representation (Fig. 1, 4, 7-9; paragraphs 6-7, 48). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to expand Tsumura system's utility with Nakagawa's idea, with the motivation of improving copyright protection, adequately (paragraph 7).

14. Applicant's arguments filed 7/14/04 have been fully considered but they are not persuasive. Applicant argument intended to differentiate electronic message from other from of digital content distribution. However, in the specification, applicant broadly referred the electronic message to all forms of digital content distribution, text, graphic, digitized video and

Art Unit: 2143

image content, they have been distributed over network in a digitized form. Especially, in page 4, lines 18-20, page, 5, lines 14-20 of the specification, the teaching referred to video distribution, in which analogous to Tsumura's teaching.

Examiner realized that the invention related to an electronic mail messaging delivery system and combination of implementing character code for the purposes of indication, filtering or the like. However, Tsumura's teaching related to an improvement of a prior system, e.g., fax, video, the system embedding an access code, e.g., copyright code, in fax or video content, e.g., electronic messages (Col. 1, lines 13-30; Col. 1, lines 63-67); the system further includes a copyright information manager, which is capable of detecting an access code in the messages, i.e. interrogate, and deciding whether to store the message in user storage device, i.e., filtering, (Col. 2, lines 5-7; Col. 4, lines 54-67; Col. 5, lines 14-31); further, Tsumura's teaching includes a unit for detecting an indication added within a message to control the use of the message at end user, e.g., permit indication allowing the information or message to store in the user storage device, non-permit indication is for temporally use only, i.e., prescribe policy (Col. 5, lines 14-30). Applicant argument is not persuasive, accordingly.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

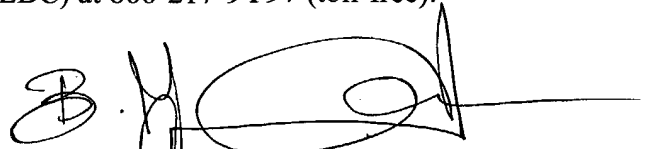
Art Unit: 2143

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a long horizontal line extending to the right.

Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj
9/4/04